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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/612,810  | 07/10/2000  | Anthony S. Bradley   | BIT-12              | 8996             |
| 22827   | 7590        | 07/25/2006           | EXAMINER            |                  |
| DORITY & MANNING, P.A.<br>POST OFFICE BOX 1449<br>GREENVILLE, SC 29602-1449 |             |                      | ADDIE, RAYMOND W    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3671                |                  |

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## ***Supplemental Examiner's Answer***

### ***Response to Arguments***

Responsive to the Supplemental Reply Brief filed on 4/17/06, a supplemental Examiner's Answer is set forth below: With respect to the newly filed arguments contained in the Supplemental Reply Brief.

In page 10, 2<sup>nd</sup> paragraph of Appellant's Reply Brief, filed 4/17/06 Appellant argues "Hepworth et al. introduces gravel into its bags...But gravel has sharp edges, and Dooleage's bags are formed of materials that will be torn to shreds by gravel with sharp edges...Thus 'to provide the barrier bags of Dooleage with solid fill materials, as taught by Hepworth et al...will destroy dooleage's bags and thereby render them useless for any purpose".

The Examiner does not concur.

Appellant has ignored the fact the claims do not specify nor limit what is equivalent to the claimed "fill material solids"; required in all the claims.

Appellant has further ignored Col. 1, Ins. 20-25, of Hepworth et al., that explicitly teaches the use of sand and cement as well as gravel.

Hence, the prior art is not as limited in its teaching as suggested by Appellant.

Further, it is pure conjecture on Appellant's part to suggest "Dooleage's bags are formed of materials that will be torn to shreds by gravel with sharp edges".

A very close review of the Dooleage patent does not appear to support Appellant's allegations of the destructive nature of gravel on Dooleage's bags.

Thus, since Appellant's arguments clearly ignore specific recitations in the Last Office Action, pertaining to specific teachings and disclosures of the prior art, as well as Appellant's conjecture of destruction, which is not supported by the prior art; the rejections of the claims based on the teachings of Dooleage and Hepworth et al. appear proper and are maintained.

Appellant argues "Examiner's Answer repeatedly and erroneously regards the Dooleage bags 11, 12 as ballast tubes...Although Dooleage discloses filling the ballast tubes with water...By being filled with water, Dooleage's bags have neutral buoyancy in water and thus cannot function as ballast tubes". See Page 13 of the Reply Brief.

However, it appears as though **only claim 35**, actually requires "A system...in a water environment", and that all other pending claims are drawn to "A system...to form a barrier or dam the system comprising" or "A system...to form a barrier; comprising" or "A method of forming a barrier or dam".

Hence, since all but claim 35, do not require "the barrier", or in the alternative "the dam" to be in a water environment, the argument about buoyancy in a water environment is moot.

However, with respect to claim 35, which is argued on Page 13 Of Appellant's Reply Brief, the preamble of Claim 35 actually recites "A system for maintaining fill material solids in position to form a barrier or dam in a water environment, the system comprising:".

The preamble does not define the limitation "water environment" nor how the "system" is arranged in the "water environment" to form "a barrier or dam". Furthermore, Claim 35 only requires "water is capable of moving into or out of the ballast tubes, the overall barrier or dam being essentially water tight on its exterior surface".

Hence, if water is permitted to flow into and out of the ballast tubes, of both Appellant's invention and that of Dooleage; then Dooleage's use of water as a ballast can not be disavowed by Appellant, since Appellants' invention is intended to permit the passage of water into and out of the ballast tubes of Appellant's invention.

Therefore, if the claim requires water to be "capable of moving into or out of the ballast tubes" and the prior art teaches water disposed inside a tube, the tube must be a ballast tube; since the teaching meets the requirements of the actual claim language. Since the prior art teaches or discloses that which is claimed, Appellant's argument that the use of water disqualifies the prior art from reading on "a ballast tube" is not persuasive, since teaching of a limitation, by the prior art cannot be used to show a lack of obviousness for that which is claimed.

Appellant then suggests Dooleage is irreconcilable with Hepworth et al., because "Dooleage makes clear that it employs water-filled bags in order to provide a water-filled flexible barricade...Hepworth et al. produces bags that are filled with sand, gravel or cement, without any water remaining in the bags".

However, the Examiner does not concur.

As clearly stated by Appellant, water is a non-compressible fluid. Hence, the degree of flexibility on the Dooleage bag appears irrelevant to the actual disclosure of Dooleage that explicitly recites "water filled bags that are suitable for damming water, directing water flow, dissipating water energy and for other purposes". See Dooleage Abstract. Hence, regardless of the ballast material chosen both sand bags and water bags are commonly known in the art to form "a barrier or dam" to include those "in a water environment".

Obviously, depending upon the intended use of the --barrier bags-- of Dooleage, it would be obvious to fill said bags with any common ballast material, such as water or sand, solely dependent upon the anticipated wave energy, or lack thereof, as explicitly disclosed by Dooleage.

Further, it is old and well known that highway barriers are commonly filled with water or sand to act as an impact-attenuating ballast, to reduce the chances of injury to a driver.

Since the invention is claimed as "a barrier or dam", the use of a particular ballast is wholly and completely dependent upon the intended use of the invention.

Since Claim 35 requires "a barrier or dam in a water environment"; neither the invention, nor the applicable prior art is limited to a dam. Nor is --a barrier in contact with a body of water" actually required by the claimed invention.

In each and every pending claim, the invention has been examined as a barrier, comprising at least: A first continuous tubular-shaped container;

At least two ballast tubes disposed within said container; and

Fill material solids held inside the ballast tubes.

Wherein the fill material solids are held in position by the ballast tubes and the first tubular shaped container to form a barrier. As exemplified by Claim 1.

To that extent, Dooleage discloses essentially all that is claimed, except for the use of a solid fill material, such as, but not limited to sand, gravel and cement.

Appellant further suggests "The differences in the structural and dynamic characteristics of a flexible water-filled structure...versus a rigid structure filled with solid material is manifestly apparent to the skilled artisan".

However, Appellant has not cited any actual claim language germane to the argument made. What structural differences are being put forth?

And how do the claims preclude the structural features of the prior art from reading on the claimed invention?

Hence, the arguments (inclusive of those made on pages 7-8 with respect to anticipated hurricane related wave action), are not persuasive and the combination of Dooleage in view of Hepworth et al., appears proper, and the rejection is maintained.

Appellant then argues on Pages 41-42, "Dooleage does not teach the provision of an additional barrier tube inside the cover 13...Dooleage teaches a separate tube, 17 (Fig.3)...Bradley fills its elongated container with solid fill to achieve a desired height...Examiner's Answer does not explain what would motivate the skilled artisan to replace the solid fill, with a ballast tube filled with water...to achieve a desired height".

Appellant's argument, erroneously suggests that the Examiner put forth replacing solid fill, taught by the Primary reference to Bradley (Appellant's current patent), with water-filled ballast tubes; which was not stated in the Examiner's Answer. Further, the rejection argued never suggested a bodily incorporation, of structural features.

Rather, the rejection of Claims 76, 77 was based on Appellant's current patent # 5,902,070, which teaches all the structural features of the claimed invention, which is the structure of the "geotube water barrier", in light of the secondary reference to

Dooleage, who teaches an obvious arrangement of geotubes, for forming a barrier of

desired height, which is explicitly taught by Dooleage, because "if a single, elongate...bag is placed transversely to water flow as a water barricade or buffer the pressure of the continuing water against the side wall of the bag will cause the bag to roll. Consequently, such a structure is not suitable, by itself as a water barricade...objects are to provide a water filled barricade that is suitable for use as a small dam, even in rough watercourses; that can be readily used to quickly form a barricade to protect people, animals and facilities from flooding; and that can be advantageously employed as a breakwater, as well as for other purposes. See Col. 1, lns. 44-50

Hence, it is logical, that when deploying a geotube as a water barrier, deploying a single geotube is less effective, than an arrangement of multiple geotubes, that interact with one another to form an effective dam. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to arrange a plurality of Bradley's geotubes (which are contain a solid fill material, in the arrangement clearly illustrated in Fig. 1 by Dooleage, to form a small dam of desired height. See Col. 1, lns. 40-Col. 2, ln. 2.

Furthermore, claims 76, 77 do not require any specific height or size of water barrier to be formed.

Appellant's argument suggesting a "Lack of Motivation" to combine, is not persuasive in light of the self evident teachings of the prior art to use a plurality of geotubes to form a small dam, even in rough watercourses.



Appellant further suggests "the express motivation in the Examiner's answer for the asserted combination makes no logical sense...this rejection is guided solely by hindsight rather than any substantial evidence of what would have been obvious".

The use of prior art, even when that prior art is owned by Appellant does not constitute the use of "Hindsight Reasoning"; when the prior art teaches all the structural features of the claimed invention.

In this case, Bradley '070 discloses the exact same "geo-tube" required to form the "elongated fabric container having two ends and at least two seams". But does not disclose the use of "ballast tubes". However, Dooleage clearly teaches the use of an elongated container (13) containing at least one ballast tube (11, 12), are advantageously deployed as a small dam, even in rough watercourses, than a single geotube". Therefore, the motivation is self-evident and not based on hindsight reasoning.

Hence, Appellant's arguments, with respect to the fill materials intended to be taught by the prior art are irrelevant, in light of the actual limitations of the claims, as opposed to alleged deficiencies argued by Appellant.

Appellant's argument suggesting "Bradley in fact makes no reference to the existence of ballast tubes all, notwithstanding that the Dooleage patent preceded the Bradley patent

by many years. Thus, the final rejection is incongruous in this regard as well" is not persuasive.

References must be evaluated for what they would have taught to be obvious to a person of ordinary skill in the art, at the time the invention was made.

Appellant then argues Dooleage only discloses more than just one water filled barrier bag".

Appellant further argues "Dooleage teaches the person of...that the wave-dissipation characteristics of one water filled barrier bag are very different from the wave-dissipation energy of more than one water-filled bag".

However, Claims 76, 77 do not require fill material of any kind. And hence make requirement nor limitation to wave-dissipation characteristics. The claims are solely directed to the structural features of the geotube water barrier as claimed.

Hence, the argument with respect to wave-dissipation characteristics, is not germane to the invention claimed.

Appellant then concludes "the rejections are deficient in their reliance upon flawed motivations for combining selected teachings from one reference with selected references from another...these selections ignore contradictory teachings...motivations are flawed for their false factual assumptions...these deficiencies and transparent

exercise of hindsight...the rejections are...mere listings of the elements in the rejected claims".

However, the Examiner does not concur.

In response to Appellant's suggestions "the rejections are...mere listings of the elements in the rejected claims"; one only need to read Claim 76, to see the rejections are written to address the structural features of the claimed invention as claimed.

As put forth above the use of prior art, even when the prior art is that of the Appellant, does not constitute "hindsight reasoning".

Rather, the use of Appellant's current patent 5,902,070 was intended to show the obvious improvement to Appellant's patented invention, and the obvious use of Appellant's current patent, as a barrier of various intended uses. Such various uses and necessary, obvious, structural additions to the patented invention, to perform the various uses are all clearly taught by the secondary references to Dooleage, Hepworth et al., Lebor and Holmberg.

Appellant's arguments suggesting the non-obvious use of "solid fill material", would tend one to believe no-one, but Appellant has discovered a patentably distinct use for putting sand in a sand bag.

However, in light of Appellant's clear disclosure in the Bradley '070 patent and the overwhelmingly well known use of sand, inside a sand bag, for use as a water barrier, is not patentably distinct, but rather a clear case of common sense.

Therefore, the rejections appear proper, and have been maintained.

Appellant's arguments pertaining to geotube size, are irrelevant and not germane to the actual language of the claims.

Appellant's arguments with respect to "wave action" and "Mother Nature's most powerful and unpredictable forces". Are also moot as being not germane to the actual language of the pending claims, since none of the claims require an ability to accommodate, support or withstand wave action. In fact **only claim 35** requires the barrier to be disposed in a water environment, without limitation as to what constitutes "a water environment", and does not explicitly require the barrier to be in contact with water at all.

Further, Appellant's arguments appear to be solely based on the assumption the Patent Office has failed to show, in each and every instance the invention is not patentable.

The Examiner maintains that a prima facie case of obviousness has been set forth with regard to all appealed claims.

The prior art clearly discloses all the structural limitations claimed, in the field of forming barriers, such as sand bags and water bags.

It is a matter of common sense, to fill a "barrier bag" with either water or sand, as a ballast, solely based upon the intended use, and the most readily available ballast material.

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Finally, Appellant's argument that the prior art only teaches solid fill material that would "destroy" the geotube, clearly ignores the limitation by Hepworth et al., to use sand, or gravel or cement.



**Raymond Addie  
Primary Examiner  
Group 3600**

7/10/06

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:



APPROVED BY  
DON E. HAJEC

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